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REMARKS

This paper is responsive to an Office Action dated May 19, 2004. Prior to this amendment claims 1-34 were pending. After amending claims 1 and 3, claims 1-34 remain pending.

The Office Action has rejected claim 1 under 35 U.S.C. 102(e) as anticipated by Goiffon et al. ("Goiffon"; US 6,453,312). Specifically, the Office Action states that, at col. 5, ln. 37-40, Goiffon discloses search syntax help that is automatically supplied in response to a search request. This rejection is traversed as follows.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Generally, Goiffon describes a query development method that uses a hierarchical concept tree. A user interface permits interactive transversal of the various relationships in the hierarchical tree structure. The word and word strings produced may be connected with logical operators to supply a search query (col. 4, ln. 1-64). At col. 5, ln. 37-44, Goiffon states that "the query development may be fully automated by programmatically invoking transversal of the hierarchical concept tree structure with the selected parameters. All character strings that are located during transversal of the hierarchical concept tree are automatically formatted into a query string that may further include logical operators added using scrip commands."

In the Detailed Description, at col. 17, ln. 31-49, Goiffon states that, "(o)nce the user has determined that all desired strings have been located in Window 502, the user selects the "Continue" button in Box 514. This causes the user to enter a screen in SSW which is a search string editor. This display allows the user to rearrange the search terms into a search string that includes standard logical operators like AND, OR, and NOT, and parenthesis to allow for search hierarchy. The syntax used to described these logical operators will be determined by a set of rules which is loaded to customize the SSW for a particular predetermined search environment..... As such, the syntax for using logical operations will vary, for example, between the use of "OR" and "+" to describe the logical "OR" function. SSW will insert the appropriate syntax required by the search tool that will is (sic) to receive the developed string."

Goiffon further states that "(t)he query may thereafter be processed by a script running on Script Server 142 to programmatically insert logical operators into the query. For example, script commands can be utilized to programmatically insert a logical operator "OR" between each of the search terms included in the query" col. 18, ln. 21-26.

In summary, Goiffon describes syntax that is dependent upon a search environment. In one embodiment, a script server automatically inserts logical operators between search terms, without human intervention (col. 20, ln. 15-21). Alternately, the search string editor can be manually controlled. However, Goiffon does not describe any mechanism that automatically helps the user understand the syntax rules of the search environment. In the lexicon of the claimed invention, Goiffon does not automatically provide a user with syntax help.

The invention of claim 1 recites a method that, in response to the search request, automatically supplies search syntax help. The Applicant respectfully submits that "supplying syntax help" is not the same as automatically inserting operators between search terms. However, to clarify the distinctions between Goiffon and claimed invention, claim 1 has been amended to recite that syntax help includes the display of syntax characters supported by the search engine (subject matter from claim 3). Since Goiffon does not describe the display of syntax characters supported by the search engine, he cannot anticipate and the Applicant respectfully requests that the rejection be removed.

The Office Action rejects claims 2-34 under 35 U.S.C. 103(a) as unpatentable with respect to Shanahan et al. ("Shanahan"; US 672,090) in view of Goiffon. The Office Action acknowledges that Shanahan fails to describe a system that systematically aids the user in building an enhanced search inquiry. The Office Action further states that it would have been obvious at the time of the invention to incorporate an advanced systematic step to develop a query, as disclosed by Goiffon, with Shanahan's system of restructuring a query, to disclose the claimed invention. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of

success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Generally, Shanahan describes a process for specifying a personality, which defines a set of document service requests that identify enrichment themes. A user-manager forms a meta-document from document content and the personality. "A scheduler selects a document service request from the set, for initiating and managing communication with a service provider to satisfy the selected document service. A content manager integrates results from the selected document service into the meta-document as document markup. The user interface, the user-manager, the scheduler, and the content manager operate together to generate or recommend new personalities or modify existing personalities using one or more in combination of a set of algebraic computations, a set of document references, a set of predefined personalities, a set of learning personalities, a knowledge level, and a classification of personalities" col. 3, ln. 1-18. Shanahan is absolutely silent on the subject of syntax and syntax help.

As described above in response to the anticipation rejection, Goiffon describes a query built from using a hierarchical tree structure. In accordance with the above-stated first *prima facie* requirement, the references themselves must suggest a reason to either modify a reference, or the knowledge generally available must provide a motivation to modify the reference in such a way as to make the claimed invention obvious. In this case, the Goiffon and Shanahan inventions are conceptually so

different that there is no motivation to combine. Because of the lack of logical correlation, Goiffon's hierarchical tree cannot be combined with Shanahan's meta-document built from personality-associated document content. Even if the references could be combined, the issue is not whether the combination suggests an enhanced inquiry process, but rather, whether the combination suggests a process for supplying syntax help when a search is made.

Further, the Office Action has not demonstrated that the modification of the cited the prior art reference points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. That is, the combination of Goiffon's logic tree and Shanahan's meta-document built from personality-associated document content, does not point to an invention that provides syntax help in response to a search inquiry.

The third requirement to support a *prima facie* case of obviousness requires that the combination of references must teach or suggest all the elements of the claimed invention. As noted above in response to the anticipation rejection, Goiffon describes a process that automatically supplies operators between search terms. Shanahan is completely silent on the subject of syntax help. With respect to claim 1, the combination of references fails to describe the claimed invention limitation of supplying syntax help in the form of supported syntax characters.

With respect to claim 18, the Office Action acknowledges that Shanahan fails to automatically display a popup window with syntax help. Goiffon describes both human and automatic processes to add operators between search terms, but he never describes a syntax help

popup window help that automatically appears in response to a search request. Therefore, the combination of Shanahan and Goiffon fails to describe the claim 18 limitations of a search syntax help popup window that automatically appears in response to selecting an edit box.

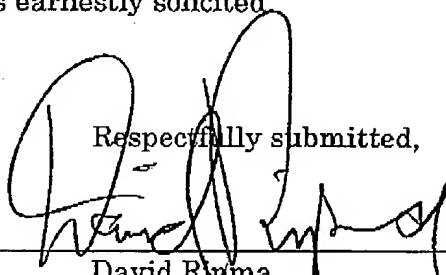
The combination of references fails to describe all the elements of the invention of claims 1 and 18. Claims 2-17, dependent from claim 1, and claims 19-34, dependent from claim 18, also enjoy the same distinctions from the cited prior art, and the third requirement to support a case of *prima facie* obviousness cannot be supported. Since the combination of references neither suggests a modification that makes the claimed invention obvious, nor explicitly describes all the limitations of the claimed invention, the Applicant respectfully requests that the rejection be removed.

It is believed that the application is in condition for
allowance and reconsideration is earnestly solicited

Date:

6/30/04

Respectfully submitted,



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